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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,561	04/28/2006	Satoru Oi	66540(46590)	3635
21874 7590 01/05/2010 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER ROBINSON, BINTA M				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
01/05/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,561

Applicant(s)

OI ET AL.

Examiner

BINTA M. ROBINSON

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 10/14/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 23 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) 34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 23, 25, 27, 30-33, 36 and 37 is/are rejected.
- 7) ☒ Claim(s) 26, 28, 29 and 38-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

The 35 USC 112, second paragraph rejection of claims 3, 6, 7, 12 and 27 and the 35 USC 112, first paragraph rejection of claim 31 are rendered moot in light of applicant's rejection and amendments filed 10/14/2009.

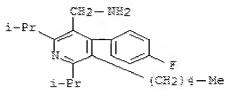
1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/09 has been entered. Claims 34-35 remain withdrawn from consideration as being drawn to a non-elected invention.

(modified rejections)

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22, 23, 25, 27, 30, 31-33, 36-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hcaplus 2001:278024 in view of Patani et. al .

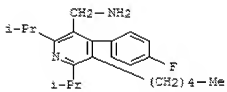


3. Hcaplus 2001:278024 teaches the compound,

The difference between the prior art compound and the instantly claimed compounds is

the teaching of an X moiety which is methyl rather than amino in the instant claim.

Patani et. al. teaches that methyl and amino. At page 3152, Patani et. al. teaches that amino and methyl are bioisosteric replacements for hydrogen. Bioisosteres are able to elicit similar biological activity or enhanced pharmacological properties to the compounds that they are replacing due to similar chemical characteristics to these compounds. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare a bioisostere which like the instant compound, is a bioisosteric compound replacement for the compound when X is equal



to hydrogen. For instance, see the compound, a disclosed species is exemplified. Accordingly, the compounds and compositions are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds and compositions over those of the prior art compounds and compositions.

(new rejection)

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

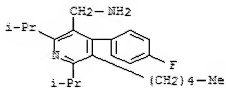
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The phrase "impaired glucose tolerance or obesity" in claim 31 is indefinite because the term or phrase "for the treatment of" has been deleted.

Response to applicant's remarks

The applicants traverse the 103 (a) rejection over Hcaplus 2001:278024 in view of Patani et. al., alleging that by amending the claims to allegedly incorporate the subject matter of claim 24 into claim 22, that this rejection is overcome. However,



compound, still renders obvious the claims 22, 23, 25, 27, 30, 31-33, 36-37, because even with the amendments to the claims which are only amendments to R1 and R2, R1 and R2 still equal C1-10 alkyl, and therefore, the 2 isopropyl groups in the position of R1 and R2 in the prior art compound render obvious R1 and R2 in the instant compounds, Q in the prior art compound is methylene which reads on the Q in the instant compound which can be C1-10 alkylene, and X is an amino group in the prior art compound which it is also in the instant compound, L is pentyl, which reads on the instant L, which can be C1-10alkylene.

Claim 26, 28-29, 38-40 are objected to for being based on a rejected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0670.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

/Binta M Robinson/
Examiner, Art Unit 1625

/Janet L. Andres/
Supervisory Patent Examiner, Art Unit 1625